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In re Application of :  
PATEL, Bipin, C., M. : DECISION ON PETITION UNDER  
U.S. Application No.: 10/521,814 : 37 CFR 1.47(b) AND PETITION  
PCT No.: PCT/GB2003/002919 : UNDER 37 CFR 1.59(b)  
International Filing Date: 04 July 2003 :  
Priority Date: 22 July 2002 :  
Attorney's Docket No.: 1768-134 :  
For: NEW ANTI-CANCER :  
COMPOUNDS :

This decision is issued in response to the "Petition For Filing A Patent Application By Other Than The Inventor Pursuant To 37 CFR 1.47(b)" and the "Petition For Expungement Of Information Or Copy Of Papers In Application File Pursuant To 37 CFR 1.59(b)" filed 27 January 2006. Applicant has submitted the required petition fees.

### BACKGROUND

On 04 July 2003, applicant filed international application PCT/GB2003/002919. The application claimed a priority date of 22 July 2002 and designated the United States. On 29 January 2004, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 22 January 2005.

On 21 January 2005, petitioner filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 18 July 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that an executed oath or declaration acceptable under 37 CFR 1.497, the surcharge for filing the declaration later than thirty months after the priority date, additional claims fees and sequence listing materials were required.

On 17 January 2006, petitioner filed a response to the Notification Of Missing Requirements (with required extension fee). The response included the required sequence listing materials, a preliminary amendment, payment of the surcharge for filing the declaration later than thirty months after priority date, and the petition considered herein. The petition seeks

acceptance of the application without the signature of the sole inventor, whom petitioner states is unavailable to execute the application papers.

## DISCUSSION

### **1. Petition Under 37 CFR 1.47(b):**

A grantable petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the nonsigning inventor; (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (5) proof of proprietary interest in the application; and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. The present petition satisfies items (1), (3), (4), and (6).

Regarding item (1), petitioner has authorized a charge to Deposit Account No. 03-1952 for the required petition fee (\$200). Based on this authorization, item (1) is satisfied.

Regarding item (2), where it is asserted that the inventor has refused to execute the application papers, section 409.03(d) of the MPEP states that a “copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.” The MPEP also requires “a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made.” Here, petitioner has provided a declaration by Tristan Brittain-Dissont, with accompanying exhibits. This declaration refers to (and includes a copy of) a letter dated 29 March 2005 to the nonsigning inventor from an attorney for the 37 CFR 47(b) applicant Psimei Pharmaceuticals plc. (hereinafter “Psimei”). This letter requests the inventor's signature on an enclosed declaration; it does not state that a copy of the complete application papers was enclosed. Mr. Brittain-Dissont's declaration also refers to (and includes copies of) subsequent correspondence between attorneys for Psimei and attorneys for the nonsigning inventor. This correspondence refers to difficulties between the nonsigning inventor and Psimei, but neither the declaration nor the attached materials include first hand evidence demonstrating that a copy of the complete application papers, with a request for the inventor's signature, has been sent to the inventor's attorney, as required before it can be concluded that the inventor has refused to execute the application. It is also noted that the correspondence referred to in the declaration involved attorneys for Psimei, not Mr. Brittain-Dissont himself. Accordingly, Mr. Brittain-Dissont is not the proper person to provide a first hand statement regarding this correspondence.

Petitioner must provide an acceptable statement from a person with first hand knowledge of the efforts made to obtain the signature of the nonsigning inventor. Such materials must demonstrate that a copy of the complete application papers, with a request for the inventor's signature, has been sent to the inventor's attorney, and that the inventor has refused to execute the required declaration. Until such materials are provided, item (2) is not considered satisfied.

Regarding item (3), the petition includes an express statement of the last known address of the nonsigning inventor. Item (3) is satisfied.

Regarding item (4), the petition includes a declaration executed on behalf of the nonsigning inventor by the 37 CFR 1.47(b) applicant, Psimei (specifically, the declaration was executed by Tristan Brittain-Dissont as Director of Psimei). Item (4) is satisfied.

Regarding item (5), section 409.03(f) of the MPEP states the following:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that: (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

In the declaration of Tristan Brittain-Dissont, petitioner asserts a proprietary interest based on an employment agreement and under the applicable laws of the United Kingdom. The MPEP states the following with respect to an agreement in writing to assign an invention:

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by a statement of facts by someone with first hand knowledge of the circumstances in which those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by a statement of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

Here, Mr. Brittain-Dissont states that the invention underlying the present application was made during the inventor's employment at Psimei, and a copy of the employment agreement has been provided. However, Mr. Brittain-Dissont does not state that he has the required first hand knowledge regarding whether the invention herein was made while the inventor was employed at Psimei, and the copy of the employment agreement provided is not fully legible (for example, the section regarding intellectual property rights cannot be read in full). Accordingly, the present record does not satisfy the requirements for demonstrating a proprietary interest pursuant to the inventor's employment agreement. Before these requirements can be considered satisfied, applicant must provide: (1) confirmation that Mr. Brittain-Dissont has the required first hand knowledge regarding the making of the invention (or a statement from a person who has such first hand knowledge); and (2) a legible copy of the employment agreement.

As for applicant's additional assertion that Psimei has a proprietary right to the invention based on the operation of the law of the United Kingdom, pursuant to MPEP section 409.03(f), a showing of such a proprietary interest requires the following:

an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

Petitioner has not supplied such a memorandum of law. Accordingly, the present record does not support a conclusion that petitioner is entitled to a proprietary interest in the present invention under the operation of the applicable law.

Based on the above, item (5) of a grantable petition (i.e., proof of proprietary interest in the application) is not satisfied on the present record.

Regarding item (6), Mr. Brittain-Dissont has made the required statement that granting of the present petition is necessary to preserve the rights of Psimei. Item (6) is satisfied.

Based on the above, petitioner has failed to satisfy all the requirements for a grantable petition.

## 2. Petition Under 37 CFR 1.59(b):

Petitioner has requested that, pursuant to 37 CFR 1.59(b), the declaration of Mr. Brittain-Dissont, and the exhibits thereto, be expunged from the file of the present application. Petitioner asserts that this is necessary in order to protect the privacy of the inventor and Psimei. As stated in the petition under 37 CFR 1.47(b), these materials were submitted by petitioner pursuant to MPEP section 724.02.

A determination on the petition under 37 CFR 1.59(b) will be held in abeyance pending a final determination on the petition under 37 CFR 1.47(b).

## CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)" and must include the materials required to satisfy items (2) and (5) of a grantable petition, as discussed above and in the applicable sections of the MPEP.

Failure to provide a proper and timely response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a).

The petition under 37 CFR 1.59(b) is **HELD IN ABEYANCE**.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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